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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/372,170	08/11/1999	TIMOTHY JOSEPH CHAINER	YO998-529	1129

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EXAMINER

SMITHERS, MATTHEW

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 06/08/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/372,170

Applicant(s)

CHAINER ET AL.

Examiner

Matthew B Smithers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-38 and 41-48 is/are allowed.
- 6) ☒ Claim(s) 1-6, 14, 19, 39 and 49 is/are rejected.
- 7) ☒ Claim(s) 7-13, 15-18 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Allowable Subject Matter***

The indicated allowability of claim 49 is withdrawn in view of the newly discovered reference(s) to an authenticating a subject using an authentication device that has the biometric sensor, memory with the stored biometric and a comparator all within the authentication device. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 14, 19, 39 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 5,623,552 granted to Lane.

Regarding claim 1, Lane meets the claimed limitations as follows:

“A method of authenticating a subject, comprising:

using one or a plurality of biometric measurements for authentication without any sharing of the subject's biometric data, by accomplishing said authentication without any of said one or plurality of biometric measurements being accessible in any form to any

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external device or external party.” see column 5, lines 6-20; column 5, lines 37-61 and Figure 2.

Regarding claim 2, Lane meets the claimed limitations as follows:

“The method according to claim 1, further comprising:

storing said biometric data in an individual unit, said individual unit belonging to said subject.” see column 5, lines 6-20 and column 5, lines 27-36.

Regarding claim 3, Lane meets the claimed limitations as follows:

“The method according to claim 2, wherein said individual unit is portable for being carried by said subject.” see column 4, line 59 to 6-20; column 5, line 5.

Regarding claim 4, Lane meets the claimed limitations as follows:

“The method according to claim 2, wherein said individual unit is non-portable.” see column 4, line 59 to 6-20; column 5, line 5.

Regarding claim 2, Lane meets the claimed limitations as follows:

“The method according to claim 2, wherein said individual unit comprises one of a smart card, a personal area network (PAN) tool, and an apparatus linked to a network.” see column 3, lines 9-35; column 5, lines 6-20; column 5, lines 37-61 and Figure 2.

Regarding claim 6, Lane meets the claimed limitations as follows:

“The method according to claim 1, further comprising: after said authentication, selectively obtaining access to any of a location, a service, and an option in a service by said subject.” see column 3, lines 9-35; column 5, lines 6-20; column 5, lines 37-61 and Figure 2.

Regarding claim 14, Lane meets the claimed limitations as follows:

"A method of authenticating a characteristic of a subject, without compromising privacy of the subject, said method comprising: using at least one of a plurality of authentication methods including personal information of the subject, a biometric: of the subject, a password, a personal identification number (PIN) and a secured component; and simultaneously with said using, said subject maintaining confidentiality of authentication information and by withholding access of-said authentication information from any ether external device or external party." see column 5, lines 6-20; column 5, lines 37-61 and Figure 2.

Regarding claim 19, Lane meets the claimed limitations as follows:

"The method according to claim 14, further comprising: selectively completing the authentication with a remote service using a communication port and protocol." see column 3, lines 9-35; column 5, lines 6-20; column 5, lines 37-61 and Figure 2.

Regarding claim 39, Lane meets the claimed limitations as follows:

"A method of identifying a subject, said method comprising:  
using one or a plurality of biometric measurements for identification without any sharing of the subject's biometric data by maintaining said biometric data as inaccessible to any external device." see column 5, lines 6-20; column 5, lines 37-61 and Figure 2.

Regarding claim 49, Lane meets the claimed limitations as follows:

"An apparatus comprising:  
a sensor to obtain biometric data;" see column 5, lines 6-10 and Figure 2, element 102  
"a non volatile memory to store biometric data from said sensor during an initiation stage" see column 5, lines 21-23 and Figure 2, element 103

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"a comparator to compare said biometric data stored in said non volatile memory with a biometric obtained by said sensor during an authentication stage" see column 5, lines 37-61 and Figure 2, element 107

"wherein said sensor, said non volatile memory, and said comparator are all located on a same device." see Figure 2.

***Allowable Subject Matter***

Claims 20-38 and 41-48 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art, Lane (US 5,623,552) fails to specifically disclose a method for secure authentication of a subject, by selectively requesting a password and/or a knowledge-based information from said subject while simultaneously interrogating biometric information of the subject which is carried by the subject and being maintained inaccessible by any external device.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Claims 7-13, 15-18, and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 7-8, 12-13, and 15-18, the cited prior art fails to specifically teach generating at least one of a password and another authentication procedure based on biometric authentication locally under the subject's control.

With respect to claims 9-11, the cited prior art fails to specifically teach generating at least one of a password and another authentication procedure based on at least one biometric feature extracted locally under the subject's control.

With respect to claim 40, the cited prior art fails to specifically teach wherein a subject's identity is determined locally, under the subject's control, by having the subject provide at least one of a user ID and by biometric identification of the subject among enrolled authorized subjects, and wherein said identification produces a set of N best matches for N subsets, and an index formed by concatenation of the N indices uniquely identifies the subject.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B Smithers whose telephone number is (703) 308-9293. The examiner can normally be reached on Monday-Friday (9:00-5:30) EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Matthew B Smithers  
Primary Examiner  
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